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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,705	10/18/2001	Mark Joseph Cleaver	0232W/00008-U	8740

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EXAMINER

SEMBER, THOMAS M

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 10/22/2002

#4

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/982,705Applicant(s)  
Cleaver et alExaminer  
Thomas SemberArt Unit  
2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 24, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:



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***Claim Rejections - 35 U.S.C. § 112***

Claims 1-18 and 23-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1.) In claim 1, lines 4-5 the recitation of "that preferentially scatters light" is vague and infinite because it is not clear if the applicant intends on limiting the claim to this feature.

2.) In claim 23, line 4 the recitation of "preferentially scattering light" is vague and infinite because it is not clear if the applicant intends on limiting the claim to this feature.

3.) In claim 34, line 4 the recitation of "preferentially light scattering" is vague and infinite because it is not clear if the applicant intends on limiting the claim to this feature.

***Claim Rejections - 35 U.S.C. § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
- (1) an application for patent, published under section 122(b), by another filed in the United

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States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-4, 14 and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Slayden. Slayden discloses an illumination device for simulating neon lighting comprising a substantially rod-like waveguide 10 having a predetermined length with a lateral light receiving surface and a lateral curved light emitting surface having a predetermined circumferential width, said waveguide being comprised of a material that preferentially scatters light entering said light receiving surface such that a light intensity pattern exiting said light emitting surface has a major axis extending along said predetermined length and an elongated light source (51, 53, 55) extending along and positioned adjacent said light receiving surface and spaced from said light emitting surface a distance sufficient to cause said light intensity pattern to have a minor axis with a length extending substantially the entire circumferential width of said light emitting surface.

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***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

2. (e) the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).
3. Claims 1-4 and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Bischoff, Jr. Bischoff, Jr. discloses an illumination device for simulating neon lighting comprising a substantially rod-like waveguide 12 having a predetermined length with a lateral light receiving surface and a lateral curved light emitting surface having a predetermined circumferential width, said waveguide being comprised of a material that preferentially scatters light entering said light receiving surface such that a light intensity pattern exiting said light emitting surface has a major axis extending along said predetermined length and an elongated light source 40 extending along and positioned adjacent said light receiving surface and spaced from said light emitting surface a distance sufficient to cause said light intensity

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pattern to have a minor axis with a length extending substantially the entire circumferential width of said light emitting surface. *Regarding claim 19*, the recitation of "capable of being flexed" is merely intended use and given very little patentable weight. Thus, Bischoff, Jr. reads on the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 16-18 and <sup>19</sup>~~34-40~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Lin. Lin discloses an illumination device for simulating neon lighting comprising a substantially rod-like waveguide 10 having a predetermined length with a lateral light receiving surface and a lateral curved light emitting surface having a predetermined circumferential width, said waveguide being comprised of a material that preferentially scatters light entering said light receiving surface such that a light intensity pattern exiting said light emitting surface has a major axis extending along said predetermined length and an elongated light source 30 extending along and positioned adjacent said light receiving surface and spaced from said light emitting

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surface a distance sufficient to cause said light intensity pattern to have a minor axis with a length extending substantially the entire circumferential width of said light

***Allowable Subject Matter***

5. Claims 5-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

6. Claims ~~22~~-39 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Reasons for allowance***

Regarding claims 5-13 and ~~22~~-33, none of the prior teaches the details of applicant's invention further including "side walls provided with a light reflecting interior surface and a light absorbing exterior surface"

Regarding claims 34-39, none of the prior art of record teaches or fairly suggest "a method of making an illumination device capable of simulating neon

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lighting comprising the steps of forming a rod with a predetermined length and a pair of lateral surfaces from material having optical waveguide properties with preferential light scattering characteristics such that light entering a first of said lateral surfaces is caused to form an **elliptically shaped light intensity pattern that has a major axis in a direction substantially parallel to said predetermined length;** placing a housing having a pair of spaced side walls defining a volume in a connected relationship with said first lateral surface; **bending said rod and housing into a desired shaped;** positioning a plurality of spaced point light sources connected to a **flexible electrical connecting member within said volume between said side walls; and filling said volume with potting material transmitting light."**

### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Consiglio, Hunter, Meggs et al disclose elongated light housing assemblies which are similar to applicant's invention. Bianchi and Boren are described in applicant's specification and now cited by the examiner in the PTO-892. Rhodes teaches embedding a light strip in a potting material.



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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is (703) 308-1938. The examiner can normally be reached on Monday - Thursday from 8:00 AM - 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea, can be reached at (703)-305-4939. The fax phone number for this group are (703) 872-9318 for regular communications and (703)-872-9319 for after-final communications.

Any inquiries of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-0956.



Thomas M. Sember  
Primary Examiner  
October 16, 2002